

ESTTA Tracking number: **ESTTA675752**

Filing date: **06/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	TBWA Worldwide Inc.
Granted to Date of previous extension	06/03/2015
Address	488 Madison Avenue New York, NY 10022 UNITED STATES
Attorney information	Susan A. Smith Kenyon & Kenyon LLP 1500 K Street, NW Suite 700 Washington, DC 20005 UNITED STATES ssmith@kenyon.com, tmdocketdc@kenyon.com, ekane@kenyon.com, jrosini@kenyon.com Phone:202-220-4200

Applicant Information

Application No	86388952	Publication date	02/03/2015
Opposition Filing Date	06/03/2015	Opposition Period Ends	06/03/2015
Applicant	Mcguinness, Megan #207 Scottsdale, AZ 85260 UNITED STATES		

Goods/Services Affected by Opposition


Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: A series of books and written articles in the field of business leadership, professional development, and business success
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Education services, namely, providing live and online workshops, classes, seminars, lectures, and conferences in the field of business leadership, professional development, and business success


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3138215	Application Date	03/08/2005
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Registration Date	09/05/2006	Foreign Priority Date	NONE
Word Mark	DISRUPTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1991/12/00 First Use In Commerce: 1991/12/00 Advertising and marketing services; business marketing consulting services; brand development and brand consulting services; market research services; advertising agency services; public relations services; and interactive marketing and advertising services</p> <p>Class 041. First use: First Use: 1991/12/00 First Use In Commerce: 1991/12/00 Workshops, forums, seminars and training in the field of advertising and marketing communications</p>		

U.S. Application No.	86564892	Application Date	03/16/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DISRUPTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 0 First Use In Commerce: 0		

	A series of books and written articles in the field of advertising and marketing		
U.S. Application No.	86355049	Application Date	08/01/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DISRUPTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Digital advertising services; advertising services, namely, promoting and marketing the goods and services of others through all public communication means; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; business consulting and information services; business organization consulting; business management consulting; business consulting services, namely, providing assistance in development of business strategies and creative ideation</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Website design and development for others; website design consultancy</p>		

Attachments	78582699#TMSN.png(bytes) 86564892#TMSN.png(bytes) 86355049#TMSN.png(bytes) Notice of Opposition DISRUPTIVE CHARM.pdf(367959 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Susan A. Smith/
Name	Susan A. Smith
Date	06/03/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application:

Serial No. : 86388952
Applicant : Megan McGuinness
Filed : September 9, 2014
Mark : DISRUPTIVE CHARM

Published in the *Official Gazette* of February 3, 2015

TBWA Worldwide Inc.

Opposer,

v.

Megan McGuinness,

Applicant.

Opposition No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, TBWA Worldwide Inc. (“TBWA”), a Delaware corporation having an address of 488 Madison Avenue New York, NY 10022, believing it will be damaged by registration of DISRUPTIVE CHARM as shown in Serial No. 86388952, hereby opposes same.

As grounds for opposition, TBWA alleges as follows:

1. Applicant, Megan McGuinness, seeks registration of DISRUPTIVE CHARM in International Class 16 for “A series of books and written articles in the field of

business leadership, professional development, and business success” and in International Class 41 for “Education services, namely, providing live and online workshops, classes, seminars, lectures, and conferences in the field of business leadership, professional development, and business success.”

2. Applicant filed Application Serial No. 86388952 on September 9, 2014, claiming an intent to use the mark for the subject goods and services. To date, no amendment to allege use has been filed.
3. TBWA is the owner of U.S. Reg. No. 3138215 for the mark DISRUPTION for advertising agency and related services in International Class 35. The mark was applied for on March 8, 2005 with a claimed date of first use of December 1, 1991. It was registered on September 5, 2006 and has since been declared incontestable. In addition, TBWA owns U.S. Application Serial No. 86564892 for the mark DISRUPTION for a “series of books and written articles in the field of advertising and marketing.” TBWA also is the owner of allowed U.S. Application Serial No. 86355049 for “business consulting and information services; business organization consulting; business management consulting; business consulting services, namely, providing assistance in development of business strategies and creative ideation.”

(Printouts showing the above registration and applications and title status are attached as Exhibit A).

4. TBWA also owns common law trademark rights in the mark DISRUPTION for books and business consulting services by virtue of its long and expansive use of the mark. In addition, TBWA owns and uses a family of DISRUPTION marks including DISRUPTION DAY and DISRUPTION WORKS (Application Serial Nos. 86333923 and 86333940).
5. TBWA has used the DISRUPTION trademark in interstate commerce since at least as early as December 1991, which is well before the filing date of the subject application.
6. TBWA has invested significant resources promoting its books and business consulting services sold under the DISRUPTION brand. As such, consumers and others regard TBWA as the origin of books and business consulting services sold under the DISRUPTION trademark.
7. Applicant's DISRUPTIVE CHARM mark is confusingly similar to TBWA's registered DISRUPTION trademark in terms of appearance, sound, and commercial meaning. Applicant's addition of the word CHARM is not sufficient to distinguish the mark or to avoid consumer confusion.
8. Applicant seeks registration of its mark for the identical goods, namely, a series of books, and for closely similar services, namely, educational services in the field of business success.

9. Applicant will likely offer her goods and services to the same types of consumers in the same channels of distribution as TBWA.
10. Applicant's proposed use of DISRUPTIVE CHARM in connection with a series of books and business education services thus is likely to cause consumers mistakenly to believe that such goods and services are somehow related to TBWA or to the DISRUPTION trademark, or that such goods and services originate from or are sponsored or approved by TBWA. This confusion and mistake will cause injury to TBWA.
11. If Applicant is awarded a registration for DISRUPTIVE CHARM in connection with a series of books and business education services as shown in Serial No. 86388952, Applicant would be entitled to the presumptions flowing from such a registration, all to the injury of TBWA.
12. TBWA timely filed a request for an extension of time to oppose the subject application and is now filing this Notice of Opposition, all within the prescribed statutory periods.
13. TBWA has not given Applicant permission to use DISRUPTIVE CHARM, a DISRUPT-formative mark, or any variant of TBWA's DISRUPTION trademark.

14. Accordingly, registration for the mark applied for under Serial No. 86388952 should be refused under the provisions of Section 2(d) of the Trademark Act.

WHEREFORE, Opposer, TBWA Worldwide Inc., requests that Application Serial No. 86388952 be rejected, that no registration be issued to Applicant, and that this opposition be sustained in favor of TBWA.

Please address all future communications regarding this opposition to:

Susan A. Smith
KENYON & KENYON LLP
1500 K Street, NW Suite 700
Washington, DC 20005
Tel.: (202) 220-4200
Fax: (202) 220-4201
tmdocketdc@kenyon.com
ssmith@kenyon.com

If any fees associated with this proceeding are required and were not paid during the course of the electronic filing process, please charge such fees to Deposit Account 11-0600 (Our Ref. 11266-360).

Respectfully submitted,

KENYON & KENYON LLP

Date: June 3, 2015

By: /Susan A. Smith/
James E. Rosini
Susan A. Smith
Erik C. Kane
KENYON & KENYON LLP
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel.: (202) 220-4200
Fax: (202) 220-4201

*Counsel for Opposer,
TBWA Worldwide Inc.*

Certificate of Service

I hereby certify that the required number of copies of the foregoing *Notice of Opposition*, including all exhibits, were served as shown below on Applicant's correspondent of record:

By U.S. Mail (Postage Prepaid)

MEGAN MCGUINNESS
14450 N. Thompson Peak Pkwy #207
Scottsdale, ARIZONA 85260

Date: June 3, 2015

By: /Susan A. Smith/
James E. Rosini
Susan A. Smith
Erik C. Kane
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220-4200
Fax: (202) 220-4201

*Counsel for Opposer,
TBWA Worldwide Inc.*

Exhibit A

The USPTO will perform maintenance affecting the Trademark Status and Document Retrieval (TSDR) system beginning at 10 p.m. Saturday, May 30 and ending at 5 a.m., Sunday, May 31 ET. TSDR will be unavailable during the maintenance period.

STATUS**DOCUMENTS**[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2015-06-03 09:25:15 EDT

Mark: DISRUPTION

DISRUPTION

US Serial Number: 78582699

Application Filing Date: Mar. 08, 2005

US Registration Number: 3138215

Registration Date: Sep. 05, 2006

Register: Principal

Mark Type: Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Sep. 13, 2012

Publication Date: Jun. 13, 2006

▼ Mark Information

[▲ Collapse All](#)

Mark Literal Elements: DISRUPTION

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

▼ Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Advertising and marketing services; business marketing consulting services; brand development and brand consulting services; market research services; advertising agency services; public relations services; and interactive marketing and advertising services

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 1991

Use in Commerce: Dec. 1991

For: Workshops, forums, seminars and training in the field of advertising and marketing communications

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 1991

Use in Commerce: Dec. 1991

▼ Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

▼ Current Owner(s) Information

Owner Name: TBWA WORLDWIDE INC.

Oct 08, 2013

COMPUTER CLAIM OPP. NO. 000000

511812

Date

Description

Proceeding

Current Location:	TMO LAW OFFICE 113	Date in Location:	Sep. 13, 2015
File Location			
TM Staff Information - None			

Affidavit of Incontestability:	Section 12 - Accepted
Affidavit of Continued Use:	Section 8 - Accepted

Mar. 12, 2002	NEW APPLICATION ENTERED IN TRAM	
Sep. 27, 2002	ASSIGNED TO EXAMINER	18354
Oct. 03, 2002	SUSPENSION LETTER WRITTEN	18354
Oct. 03, 2002	LETTER OF SUSPENSION E-MAILED	0335
Apr. 03, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 22, 2006	ASSIGNED TO FIE	18084
Apr. 28, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	18084
May 24, 2006	NOTICE OF PUBLICATION	
Jun. 13, 2006	PUBLISHED FOR OPPOSITION	
Sep. 02, 2006	REGISTERED-PRINCIPAL REGISTER	

Date Recorded: Sep. 19, 2005**Supporting Documents:** [assignment-tm-3161-0315.pdf](#)**Assignor****Name:** [OMNICOM HOLDINGS INC.](#)**Execution Date:** Sep. 13, 2005**Legal Entity Type:** CORPORATION**State or Country Where
Organized:** DELAWARE**Assignee****Name:** [TBWA WORLDWIDE INC.](#)**Legal Entity Type:** CORPORATION**State or Country Where
Organized:** DELAWARE**Address:** 488 MADISON AVENUE
NEW YORK, NEW YORK 10022**Correspondent****Correspondent Name:** JEFFREY C. KATZ**Correspondent Address:** 1740 BROADWAY
DAVIS & GILBERT LLP
NEW YORK, NY 10019**Domestic Representative - Not Found****▼ [Proceedings - Click to Load](#)**

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STATUS

DOCUMENTS

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Mark: DISRUPTION

DISRUPTION

US Serial Number: 86564892

Application Filing Date: Mar. 16, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: New application will be assigned to an examining attorney approximately 3 months after filing date.

Status Date: Mar. 25, 2015

▼ Mark Information

[▲ Collapse All](#)

Mark Literal Elements: DISRUPTION

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

▼ Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: A series of books and written articles in the field of advertising and marketing**International Class(es):** 016 - Primary Class**U.S Class(es):** 002, 005, 022, 023, 029, 037, 038, 050**Class Status:** ACTIVE**Basis:** 1(b)▼ **Basis Information (Case Level)****Filed Use:** No**Currently Use:** No**Amended Use:** No**Filed ITU:** Yes**Currently ITU:** Yes**Amended ITU:** No**Filed 44D:** No**Currently 44D:** No**Amended 44D:** No**Filed 44E:** No**Currently 44E:** No**Amended 44E:** No**Filed 66A:** No**Currently 66A:** No**Filed No Basis:** No**Currently No Basis:** No▼ **Current Owner(s) Information****Owner Name:** TBWA Worldwide, Inc.**Owner Address:** 488 Madison Avenue
New York, NEW YORK 10022
UNITED STATES**Legal Entity Type:** CORPORATION**State or Country Where
Organized:** DELAWARE▼ **Attorney/Correspondence Information****Attorney of Record****Attorney Name:** Susan A. Smith**Docket Number:** 11266/360**Attorney Primary Email
Address:** tmdocketdc@kenyon.com**Attorney Email Authorized:** Yes**Correspondent**

▲ Proceedings - Click to Load

Current Location: NEW APPLICATION PROCESSING

Date in Location: Mar. 22, 2012

File Location

TM Staff Information - None

Mar. 18, 2012

NEW APPLICATION ENTERED IN TRAM

Mar. 22, 2012

NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM

Date

Description

Proceedings

The USPTO will perform maintenance affecting the Trademark Status and Document Retrieval (TSDR) system beginning at 10 p.m. Saturday, May 30 and ending at 5 a.m., Sunday, May 31 ET. TSDR will be unavailable during the maintenance period.

STATUS**DOCUMENTS**[Back to Search](#)

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Mark: DISRUPTION

DISRUPTION

US Serial Number: 86355049

Application Filing Date: Aug. 01, 2014

Register: Principal

Mark Type: Service Mark

Status: Notice of Allowance (NOA) sent (issued) to the applicant. Applicant must file a Statement of Use or Extension Request within six months of the NOA issuance date.

Status Date: Feb. 03, 2015

Publication Date: Dec. 09, 2014

Notice of Allowance Date: Feb. 03, 2015

▼ Mark Information

[▲ Collapse All](#)

Mark Literal Elements: DISRUPTION

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

▼ Related Properties Information

Claimed Ownership of US [3138215](#)
Registrations:

▼ Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Digital advertising services; advertising services, namely, promoting and marketing the goods and services of others through all public communication means; advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; business consulting and information services; business organization consulting; business management consulting; business consulting services, namely, providing assistance in development of business strategies and creative ideation

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(b)

For: Website design and development for others; website design consultancy

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

▼ Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

▼ Current Owner(s) Information

DSfE

Description

БЛОКЕРА!

▲ Proceedings - Click to Load

Current Location:		INTENT TO USE SECTION	Date in Location:		Feb. 03, 2012
File Location					
TM Attorney:		MCMORROW, JANICE LEE	Law Office Assigned:		LAW OFFICE 112
TM Staff Information					

Aug. 02, 2014	NEW APPLICATION ENTERED IN TRAM			
Aug. 11, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM			
Oct. 21, 2014	ASSIGNED TO EXAMINER			13305
Oct. 21, 2014	EXAMINER'S AMENDMENT - WRITTEN			13305
Oct. 21, 2014	EXAMINER'S AMENDMENT E-MAILED			0358
Oct. 21, 2014	NOTIFICATION OF EXAMINER'S AMENDMENT E-MAILED			0358
Oct. 21, 2014	EXAMINER'S AMENDMENT ENTERED			88888
Oct. 21, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER			
Nov. 02, 2014	ASSIGNED TO FIE			10208
Nov. 02, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED			10208